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In the Supreme Court of the United States

OCTOBER TERM, 1967

No. 386

STEWART-WARNER CORPORATION
Petitioner

vs.

BISHMAN MANUFACTURING CO. AND GEORGE T. HEMMETER
Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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FOREWORD

The present petition for writ of certiorari is opposed and should be denied because it does not present any question that even remotely justifies consideration or intervention by this Court. It has obviously been brought for the sole purpose of further delaying enforcement of the judgment entered by the District Court and which was unanimously affirmed by the United States Court of Appeals for the Seventh Circuit.

In its effort to present the "special and important reason" for review, required by this Court's Rule 19, petitioner contends that there is decisional conflict between this

and other courts that should be resolved. This contention, however, is also without merit because the alleged conflict does not exist, except, at most, as a fiction built around a distorted presentation of the facts and a misinterpretation of the allegedly conflicting decisions.

It is also to be noted that the petition not only does not raise a constitutional issue but emphasizes (P. 3) that no statutory provision is involved. Thus it relies entirely on certain assumed equitable considerations, as the basis for its request that this Court "resolve the uncertainty which now (supposedly) exists in that (this) area of the law" (P. 15).

In doing so, however, the petition completely ignores the established fact that the equities, as well as the facts and the law, in this case overwhelmingly support the respondents' position throughout. This will be perfectly evident from a reading of the trial court's fifty findings of fact (R. 473-486) from which it is clear that during the early negotiations between respondent Hemmeter and petitioner, the latter's patent department not only drafted the claim in suit, in the hopes of obtaining a license thereunder, but that its highly trained engineers took full advantage of the practical know-how, obtained from Hemmeter, in substantially copying every detail of his balancer. This was even conceded in petitioner's brief to the court of appeals wherein (P. 44) it was said that "defendant does not quarrel with the District Court's holding (finding 50, R. 486) that the radially spaced rotating counterweights of its balancers are the functional and mechanical equivalents of the counterweights mounted 'for rotation in axially-spaced planes' called for by claim 4 of the Hemmeter '003 patent."

Under these circumstances the experienced courts below,

properly disposed of the hard factual and legal issues presented, and with equal propriety, refused to recognize the artificial equities which defendant-petitioner has repeatedly attempted to provoke in its own behalf.

For sake of consistency and convenience the decisions below will herein be referred to as they appear in the appendices to the petition (i.e., Apps. A, B, C, etc.), the abbreviations noted on page 2 of the petition will be adopted, and the petition itself will be designated as (P. ——).

THE PREMISES FOR THE PETITION ARE ERRONEOUS

Respondents submit that the present petition is predicated on assumptions and inferences which are misleadingly inaccurate and particularly in the following significant respects:

(a) Petitioner's infringing balancer is incorrectly described.

(b) The alleged estoppel does not exist.

(c) There is no conflict between decisions.

ARGUMENT

(a) Petitioner's infringing balancer is incorrectly described.

In describing "The Wheel Balancers Involved In This Action" (P. 4) petitioner states that the claimed Hemmeter balancer has a pair of counterweights that recycle "in axially spaced planes" while the Stewart-Warner device has counterweights that recycle "in common planes of rotation,

but radially spaced." This half-truth is then aggravated by the presumption (footnote P. 5) that "there are, of course, only two possible arrangements" for mounting such weights i.e., "they must be axially spaced . . . or radially spaced." Ergo, it must also follow that there is a sharp distinction between the two.

The conclusion thus reached is fallacious because the attempted distinction is fictitious. Otherwise, on such a basic issue, surely petitioner should have presented to this Court some illustration of the infringing device, but that has significantly not been done.

Nor is there any proof in this case that for weights to recycle past each other they must be "axially—*or*—radially spaced." In fact petitioner's own device is a combination of ***both*** axial ***and*** radial spacing, as pointed out in the trial court's finding 47 (R. 485) wherein it is made crystal clear that:

> "In defendant's . . . balancer the rotatable weight members consist of two radially extending arms . . . to the outer ends of which are attached lugs, the arm and lug of each member forming the weight proper. The arm portions of the two weights are axially spaced while the lugs thereof are radially spaced, etc."

The foregoing finding was never challenged in the courts below, and, as petitioner's present position on this basic premise is clearly inconsistent with the finding the attempted structural distinctions must be rejected.

(b) The alleged estoppel does not exist.

Under the caption of "Questions Presented" the petition (P. 2) categorically presumes the existence of file wrapper estoppel, and then proceeds to philosophize on how estop-

pel should supposedly be "measured" or "limited." The position taken is tenuous as well as inconsistent with itself.

There is no denying that Hemmeter's original claim 11 (R. 378) can be read on petitioner's balancer. But what of it? The claim as thus filed was clearly invalid for numerous reasons including the one that it was too broad. As the trial court said (R. 149) "This (claim 11) was asking for the moon. They didn't get it."

The doctrine of file wrapper estoppel is a rule, and a salutary one, that precludes a patentee from interpreting a claim of his patent to recapture the substance of a broader claim that he cancelled during the prosecution of his application in order to obtain the issued claim. In short, a patentee cannot reclaim what he has disclaimed to get his patent. Prior art considerations have no bearing on the problem, as made clear by the appeal court's order (App. C. 15a) amending its original opinion.

As stated in the amended opinion (App. A, 6a):

> "A necessary condition for the establishment of a file wrapper estoppel is that the patentee must have narrowed his claim in response to an objection by the Patent Office *in order to obtain the patent.*" (Emphasis added.)

Furthermore, in so ruling the appeal court specifically cited and relied on the very Supreme Court decisions which petitioner now contends are in conflict with the opinion, namely, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126 (1942), and *I.T.S. Rubber Co. v. Essex Rubber*, 272 U. S. 429 (1926).

In *Exhibit Supply* the patentee was clearly attempting to construe his claim 7, in suit, to mean exactly what it meant before being amended, and this was denied as an

attempt "to recapture claims which the patentee has surrendered by amendment" (315 U. S. at 136).

Likewise, in *I.T.S. Rubber* this Court found that because the patentee had narrowed his claim "in order to secure his patent . . . (he) is therefore estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto" (272 U. S. at 443-444).

Even petitioner concedes that a prerequisite to estoppel must include an attempt "to cover subject matter the patentee unsuccessfully attempted to claim in his application" . . . and "as a condition for granting the patent" (P. 3).

Finally, and as a significant matter which petitioner chooses to ignore, the Hemmeter file history does not contain a single earlier claim directed to the three weight inventive concept defined by the claim 4 in suit, and not even petitioner has so contended. This is the all-important consideration in determining validity and infringement, while the "axial spacing" expression was never even mentioned in the Patent Office as a condition for the allowance of the claim.

This whole subject was disposed of in detail by the court of appeals (App. A, 5a-6a), and in a manner completely consistent with the law and the facts. Consequently its conclusion that "the doctrine of file wrapper estoppel is therefore inapplicable" is equally sound.

(c) There is no conflict between decisions.

As already noted the Amended Seventh Circuit decision (App. A) is not at all in conflict with this Court's decisions in *Exhibit Supply* and *I.T.S. Rubber*. Nor does it disagree with *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.

S. 211, where, again, the Court properly rejected the patentee's attempt "to revive cancelled or rejected claims and restore them to their patents" (at 240).

There is also no conflict between the Fifth Circuit decision in *Hunt Tool Co. v. Lawrence*, 242 F. 2d 347, and those by this Court, or other courts of appeal. In *Hunt*, which closely parallels the present situation, and in which certiorari was denied (77 S. Ct. 1296) in 1957, the Court recognized the established doctrine of file wrapper estoppel as applicable when a patentee is "claiming a construction for the unchanged and allowed claims that would in effect recapture the territory initially abandoned . . . (adding) this is not so here" (at 353).

CONCLUSION

There is clearly no conflict, express or implied, between the reported decisions of the various appellate courts on the issue of file wrapper estoppel, and since the alleged uncertainty which is said to be present in this area of the law simply does not exist the subject petition should be summarily denied.

Respectfully submitted,

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